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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,738	09/28/1999	OLIVIER FONCARNIER	FR9-98-059	3148

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IBM CORPORATION
3039 CORNWALLIS RD.
DEPT. T81 / B503, PO BOX 12195
REASEARCH TRIANGLE PARK, NC 27709

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/29/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/407,738

Applicant(s)

FONCARNIER, OLIVIER

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been reviewed. Claims 1-21 are not amended; Claims 22-24 are added. Claims 1-24 are pending for examination, the objections and rejections cited are as stated below.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of the selecting means and step for selecting a list of users as recited in claims 22-24, must be shown in the drawings or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make/or use the invention, i.e., failing to disclose list of user is a subset of the plurality of users. Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976). In fact applicant's disclosure did not even sufficiently include selecting means and method step of selecting a list of users, which is a subset of the plurality of user, based on profile information in the profile table on which the claimed method and system could be implemented.

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5. Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

6. Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new features added in claims 22-24, i.e., a means, step and computer program for selecting a list of user, wherein a list of user is a subset of a plurality of users, was not describe in the specification or the claims as originally filed.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

8. Stupex and Drala were cited as prior art in the last office action. The teachings that applicable are respectfully maintained and incorporated by reference as set forth in the last office action.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 22-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Raffel et al. (U.S. 2002/0082892).

11. As to claims 22-24, Raffel discloses a method, program and apparatus for sale force management, which includes a plurality of profiles, list of users and selectively notify users in the list according to profile criteria are met, the system comprising:

profiling in a profile table each one of said plurality of users (Fig. 6);

processing and transmitting means enabling an administrator associated with said server to transmit alarm message to the list of users wherein said users have been selected from said profile table, said alarm message being displayed on a screen of a workstation associated with each selected user if said workstation is running; selection means for selecting, in response to a condition or an event, a list of users based on profile information in the profile table wherein the list of users is a subset of the plurality of users (list of users fig. 5, each user profile, Fig. 6, 8, selectively notifying users in the list, Fig. 13; administrator, Fig. 5; user receiving notification via its terminal screen, paragraphs 83, 103-107, 207).

12. Claims 22-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ruckdashel et al. (U.S. 6,038,542).

13. As to claims 22-24, Ruckdashel discloses a method, apparatus and program for notification users based on their profile, comprising:

a profile table each one of said plurality of users, (A server includes a scheduling database, which contains a list of users and their properties, e.g., profile table (Fig. 2, 4);

processing and transmitting means enabling an administrator associated with said server to transmit alarm message to the list of users wherein said users have been selected from said profile table, said alarm message being displayed on a screen of a workstation associated with each selected user if said workstation is running; selection means for selecting, in response to a condition or an event, a list of users based on profile information in the profile table wherein the list of users is a subset of the plurality of users (An administrator capable of modifying users list, Fig. 3; Users capable of specifying which event to be notified, each of the users capable of specifying notification configuration, Fig.5, 7; The server reads the users list, accesses users schedule; Fig. 8; The server sends notification to the users whose profile met the criteria, Fig. 9; also see Col. 4-12).

14. Applicant's arguments filed on 12/17/2003 have been fully considered but they are not persuasive. In the remarks, applicant argued in substance that:

(a) Prior art failed to teach administrator associated with a server sending alarm to a list of user, selected from a plurality of users within a profile table, as recited in claims 1, 8 and 15.

As to point (a)., Examiner disagreed, there is no support in neither specification nor claims that suggested a list of user is or must be selected from users within a profile table. Without specific support, the examiner can interpret the claims' language as, selecting user(s) based on his or her profiles and sending a notification to the user(s) whose profile meet a criterion. Further, the examiner noted that the claims language read on many event notification systems, e.g., contact list notification, news or services subscribing, which send the notification on users registration, subscriptions or users profiles basis. Since, there is no specific profile

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structure was taught in the disclosure. The examiner, therefore, allowed to give the broadest reasonable interpretation to such claims' limitation. Furthermore, nowhere in the disclosure that suggested a list of users, i.e., user names, must be within the profile table, thus, a database contains objects' profile could be construed as a profile table. It is not necessarily that the profile must contain list of users' name, it could be a plurality of object's profiles, which are associated with a plurality of users. Selectively, bases on a criterion, the system could form a list of users from the profiles that met the criterion, for receiving the notification(s). And, that was taught in Stupex, the interconnection engine relays a particular event based on registration information, (Col. 9, lines 1-46); in one embodiment it includes action category that includes threshold tools allow the user to be notified whenever the certain condition arise, (Col. 7, lines 10-64).

(b) The examiner hindsight.

As to point b., in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to be 'B. Jaroenchonwanit', written over a horizontal line.

Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
1/22/04